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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/629,547	04/09/96	TAKAHASHI T	ATS-032-CON/

EXAMINER

35M1/1023

ART UNIT	PAPER NUMBER
3502	14

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DATE MAILED: 10/23/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 7/22/1997 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 1-12, 16, 28, 31 are pending in the application.
   Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 13-15, 17-27, 29-30, 32-42 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-12, 16, 28, 31 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☒ The proposed additional or substitute sheet(s) of drawings, filed on 7/22/97 has (have) been ☒ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☒ been filed in parent application, serial no. 07/485,659; filed on 2/27/1990.
13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

PTOL-326 (Rev. 2/93)

1. The proposed drawing corrections filed on March 17, 1997 has been disapproved by the examiner because it introduces new matter in new Fig. 5. For example, the original Fig. 3 shows that a surface 5b of the flywheel 5 is in contact with an outer surface of the reinforcing member 4, however, new Fig. 5 shows a gap between surface 5b and the surface 4n or 4j of the reinforcing member 4. The gap located between surfaces 5b and 4n is not disclosed on the filing date of the original patent, thus, it introduces new matter.

2. The proposed drawing corrections filed on July 22 and May 23, 1997 have been approved by the examiner.

3. The Second Supplemental Amendment filed on July 22, 1997 (Paper No. 12) has been entered.

4. The Amendment filed on March 17, 1997 (Paper No. 6) and the (first) Supplemental Amendment filed on May 20, 1997 (Paper No. 10) have not been entered because Paper Nos. 6 and 10 are informal/nonresponsive for the reasons set forth in the Office communication mailed on June 23, 1997 (Paper No. 11).

5. The amendment filed on July 22, 1997 (Paper No. 12) is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention.

The added material which is not supported by the original disclosure is, *e.g.*, as follows:

(A) the insertion in line 43 on page 3 of the specification. Note that new Fig. 5 filed

on March 17, 1997 introduces new matter such as the gap between the surfaces 5b and 4n as stated in the disapproval for drawing correction above; and

(B) the insertion --The inner portion 2f of the elastic plate 2 is *surrounded* by the outer portion 2b of the elastic plate 2-- in page 3, column 3, line 47, through page 4, column 4, line 27. Note that applicant merely shows a longitudinal cross sectional view of the crankshaft or flywheel assembly on the filing date of the original patent. The inner portion 2f of the elastic plate 2 *may or may not be surrounded* by the outer portion 2b of the elastic plate 2 if it is shown in a side view, perspective view, or exploded view of the flywheel assembly. Since applicant did not show the side view, perspective view or exploded view on the filing date, therefore, it was unclear whether the inner portion 2f of the elastic plate 2 is *surrounded* by the outer portion 2b of the elastic plate 2 or not on the filing date. The recital of a specific inner portion 2f *surrounded* by the outer portion 2b within a full spectrum of possible inner portions is considered under the present disclosure to be new matter. *Cf.*, *In re Smith*, 173 USPQ 679 (CCPA 1972) and *Ex parte George*, 230 USPQ 575, 578 (Bd. Pat. App. & Inter. 1986).

Applicant is required to cancel the new matter in the response to this Office action.

6. The reissue oath or declaration filed with this application is defective because it fails to describe the **actual error(s) in the patent**, *i.e.*, it fails to particularly specify the "defects" in the specification or drawings, 37 CFR 1.175 (a)(2); and/or it fails to distinctly specify the **"excess or insufficiency"** in the claims, 37 CFR 1.175(a)(3).

Page 3 *et seq.* of the original Declaration filed on April 9, 1996 alleged that the claims of the Patent No. 5,465,635 (Pat.'635) are not broad enough to encompass the device shown in the attached Fig. A. Similarly, the Declarations by Noninventor in Support of Reissue under 37 CFR 1.175(b) filed on March 17, 1997 (Paper No.8) likewise assert that applicant's patented claims are not sufficiently broad to cover the new embodiments shown in the attached Figs. A and B.

However, it is well settled that the allegations of the inventor's ignorance of drafting and claiming technique to adequate encompass the invention and counsel's ignorance of the invention is unavailing. Those allegations could be frequently made, and, if accepted as establishing errors, would require the grant of reissue on anything and everything mentioned in a disclosure. *In re Weiler*, 229 USPQ 673, 677 (CAFC 1986)(footnote 4). Moreover, section 1402 of MPEP points out that the reissue applicant's failure to timely file a continuation/divisional application to cover the possible new embodiments is not considered to be an error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than they had a right to claim; and thus such applicant's error is not correctable by reissue of the original patent under 35 USC 251.

7. The reissue oath or declaration filed with this application is defective because it fails to particularly specify the errors and/or how the errors relied upon arose or occurred as required under 37 CFR 1.175(a)(5). *Included are inadvertent errors in conduct, i.e., actions taken by the applicant, the attorney or others, before the original patent issued, which are alleged to be the cause of the actual errors in the patent.* This includes how and when the errors in conduct arose or occurred, as

well as how and when these errors were discovered. Applicant's attention is directed to *Hewlett-Packard v. Bausch & Lomb*, 11 USPQ2d 1750, 1758 (Fed. Cir. 1989).

Applicant's original Declaration and Supplemental Declarations (Paper No. 8) did not describe the *actions taken by the applicant, the attorney or others, before the original patent issued, which are alleged to be the cause of the actual errors* ***in the patent.*** In fact, applicant's Declarations merely describe that the claims in the issued patent are not sufficiently broad to cover the new embodiments which were not disclosed in the patent. It is unclear as to why the discovery of the device shown in Fig. A attached to the original Declaration and in Figs. A and B attached to Paper No. 8 after the issuance of the patent: (1) renders the original patent to be wholly or partially invalid; and (2) creates an error **prior to** filing the prosecution of SN'659 and SN'526. See *In re Constant*, 3 USPQ2d 1479 (CAFC 1987). Note that the reissue is improper because there had been no error in issuing the original patent claims within the meaning of 35 USC 251. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992 (CAFC 1993).

8. Claims 1-12, 16, 28 and 31 are rejected as being based upon a defective reissue Declarations under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

9. In view of the fact that additional errors in the original patent have been corrected through amendments to the specification, claims and drawings, a new/supplemental oath or declaration complying with 37 CFR 1.175(a)(1), (a)(2) and/or (a)(3), (a)(5), (a)(6), and (a)(7) is required. See *In re Constant, supra.*

10. Applicant's arguments filed July 22, 1997 (Paper No. 12) , May 20, 1997 (Paper No. 10) and March 17, 1997 (Paper No. 6) have been fully considered but they are not persuasive.

Applicant contends, *inter alia*, that claims 16, 28 and 31: (a) are boarder than the issued patent claims 1 and 8 but distinguish over Numata'542 and JP'639; and (b) clearly do not have substantially the same scope as the appealed claims 16 and 18 of the parent application, thus, the rejections based on *res judicata* should be withdrawn.

The rejections based on art and *res judicata* have been withdrawn. Applicant's arguments are moot.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

12. Submission of your response by facsimile transmission is encouraged. Group 3500's facsimile number is **(703) 305-3597**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and

delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

> I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-3597) on _____
> (Date)
> Typed or printed name of person signing this certificate:
>
> _____
>
> _____
> (Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday from 7:30 AM EST to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, can be reached on (703) 308-0830. The fax phone number for this Group is (703) 305-3597 or (703) 305-3598.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**charles.marmor@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where **there exists a possibility that sensitive information could be identified or exchanged** unless **the record includes a properly signed**

express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

Luong

October 20, 1997.

VINH T. LUONG
PRIMARY EXAMINER
ART UNIT 352